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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No.: 2003-1196 09/667,826  
Application No.: ~~00/110,545~~ Confirmation No.: 9090  
Applicant(s): Cannata et al.  
Filed: 9/21/2000  
Art Unit: 2878  
Examiner: Hannaher, Constantine  
Title: Infrared Imaging System Employing On-Focal Plane  
Nonuniformity Correction

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Attorney Docket No.: 901.0013.USU  
Customer No.: 29,683

Commissioner For Patents  
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Supplemental Reply Brief

Sir:

This is in response to the Supplemental Examiner's Answer mailed 1/4/2005 in regard to the above-identified reissue patent application. The examiner stated that the decision in Ex parte Eggert, Appeal No. 2001-0790 (BPAI decided May 29, 2003) was not considered to be applicable to the facts of this appeal. Appellants' attorney respectfully disagrees.

This cases was remanded to the examiner on 8/1/2003 with "special" status for immediate action. Unfortunately, it was 17 months before the supplemental examiner's answer was mailed. There have been various changes in the law since this reissue patent application was filed over four years ago. If the Board believes that there is further case law that has issued since its remand, which should be addressed regarding

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this case, they are requested to bring it to the attention of the undersigned and the examiner.

Ex parte Eggert appears to be directly relevant regarding this case. As the Board indicated in citing Mentor Corp. v. Coloplast Inc., 998 F.2d 992, 27 USPQ2d 1521 (Fed Cir. 1993), the recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application. In the present case, the broadened reissue claims are narrower than the claims cancelled from the original application. Thus, the recapture rule does not appear to apply.

In the present case, claim 40 is substantially the same as claim 1 of the patent, with the exception that it does not contain the limitation of "parallel connected" circuit elements (but it contains circuit elements). Claim 1 of the patent was originally claim 2 of the originally filed patent application and was dependent upon claim 1. In the first office action, the examiner indicated that claim 2 would be patentable in independent form, but rejected claim 1. Claim 1 was subsequently cancelled and its features were added to claim 2 to transform claim 2 into an independent claim. The term "parallel connected" was originally in claim 2; it was not added from claim 1.

Following the steps outlined in Ex parte Eggert for analysis of whether or not the recapture rule should apply, claim 40 should be compared to original claim 1 which was cancelled. Claim 1 constitutes the surrendered subject matter. In the

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present case, claim 40 is narrower than original claim 1; not broader. Claim 40 is narrower than the surrendered subject matter. This is the same type of situation noted on page 44 of the Decision in Ex parte Eggert; namely, appellants made an error in limiting the [invention] more narrowly than was required to overcome the prior art rejection, thereby claiming less than they had a right to claim in the patent. This is the type of error which can be corrected by reissue under 35 USC 251. To hold otherwise would controvert the remedial nature of the statute.

New dependent claims 41-50 add additional limitations to claim 40 and further exemplify that the recapture rule should not be applied to these claims.

New independent claim 52 is substantially similar to patent claim 26 with the exception that it does not contain the limitation of "parallel connected" circuit elements (but it contains circuit elements). Claim 26 of the patent was originally claim 24 of the originally filed patent application and was dependent upon claims 23 and 1. In the first office action, the examiner indicated that claim 24 would be patentable in independent form, but rejected claims 23 and 1. Claims 23 and 1 were subsequently cancelled and their features were added to claim 24 to transform claim 24 into an independent claim. The term "parallel connected" was originally in claim 24; it was not added from claim 23 or claim 1.

Similar to claim 40 noted above, following the steps outlined in Ex parte Eggert for analysis of whether or not the

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recapture rule should apply, claim 52 should be compared to original claims 23 and 1 which were cancelled. Claims 23 and 1 constitutes the surrendered subject matter. In the present case, claim 52 is narrower than original claims 23 and 1; not broader. Claim 52 is narrower than the surrendered subject matter.

New independent claim 53 is substantially similar to patent claim 27 with the exception that it replaces the term "capacitors" with --circuit elements-- and changes the last line from ", wherein said plurality of switches are selectively turned on and off to provide a desired amount of discrete offset correction for each detector element" to --, wherein said plurality of switches selectively provide a desired amount of discrete offset correction for each detector element--.

Claim 27 of the patent was originally claim 33 of the originally filed patent application and was dependent upon claims 32, 31, 30 and 29. In the first office action, the examiner indicated that claim 33 would be patentable in independent form, but rejected claims 32, 31, 30 and 29. Claim 32, 31, 30 and 29 were subsequently cancelled and their features were added to claim 33 to transform claim 33 into an independent claim. The terms changed in claim 52 were originally in original claim 33; they were not added from claims 32, 31, 30 and 29.

Similar to claim 40 noted above, following the steps outlined in Ex parte Eggert for analysis of whether or not the recapture rule should apply, claim 53 should be compared to

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original claims 32, 31, 30 and 29 which were cancelled. Claims 32, 31, 30 and 29 constitute the surrendered subject matter. In the present case, claim 53 is narrower than original claims 32, 31, 30 and 29; not broader. Claim 53 is narrower than the surrendered subject matter.

New dependent claims 54-57 add additional limitations to claim 53 and further exemplify that the recapture rule should not be applied to these claims.

New independent claim 58 is substantially similar to patent claim 35 with the exception that it does not contain the limitation of "parallel connected" constant current sources (but it contains constant current sources). Claim 35 of the patent was originally claim 37 of the originally filed patent application and was dependent upon claims 31, 30 and 29. In the first office action, the examiner indicated that claim 37 would be patentable in independent form, but rejected claims 31, 30 and 29. Claims 31, 30 and 29 were subsequently cancelled and their features were added to claim 37 to transform claim 37 into an independent claim. The term "parallel connected" was originally in claim 37; it was not added from claims 31, 30 and 29.

Similar to claim 40 noted above, following the steps outlined in Ex parte Eggert for analysis of whether or not the recapture rule should apply, claim 58 should be compared to original claims 31, 30 and 29 which were cancelled. Claims 31, 30 and 29 constitute the surrendered subject matter. In the present case, claim 58 is narrower than original claims


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31, 30 and 29; not broader. Claim 58 is narrower than the surrendered subject matter.

The cancelled claims constitute the surrendered subject matter for purposes of evaluating the reissue recapture rule. Appellants made an error in limiting the invention more narrowly than was required to overcome the prior art rejection, thereby claiming less than they had a right to claim in the patent. This is the type of error which can be corrected by reissue under 35 USC 251. To hold otherwise would controvert the remedial nature of the statute.

The Board is requested to reverse the examiner's rejection based upon the reissue recapture rule.

Respectfully submitted,

  
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3/4/05  
Date

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

March 4, 2005  
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